| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/691,723 | 10/22/2003 | David J. Muoio | MSFT-2824 / 183209.05 | 6838 |

| | | | EXAMINER |
|---|---|---|---|
| 41505 | 7590 | 06/07/2006 | EISEN, ALEXANDER |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2629 | |

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/691,723 | MUOIO ET AL. |
| | Examiner | Art Unit | |
| | Alexander Eisen | 2629 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>22 October 2003</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☒ Claim(s) <u>14</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>4/14/05</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Objections*

1.      Claim 14 is objected to because of the following informalities:  Claim apparently has

graphically overlapping and overlaid lines reciting the same limitations resulting in deciphering

the claim as the following: "14. A system for applying effects to a physical environment having a

plurality of physical spaces, comprising: a computer having a plurality of computer-readable

instructions for providing a plurality of logical groups where each logical group corresponds to a

plurality of the physical spaces *of computer readable instructions capable of executing on the*

*computer for selecting one of the logical groups*; a plurality of computer readable instructions

capable of executing on the computer for selecting an effect to be applied to the selected logical

group; an interface capable of transmitting a signal indicative of the physical effect to computing

devices associated with each physical space in the logical group so that the computing device

may cause the effect to be applied to the physical space". The emphasized text should be

probably deleted from the claim.  Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

2.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.      Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.  Under current official guidelines a data signal is considered a

nonstatutory subject matter. The basic rationale for this is that a signal is not a machine, or

process, or a manufacture or a composition of matter. A program code, however, if recorded on a

computer readable medium and executed on a computer, is considered a statutory subject matter.

Hence, an appropriate amendment to the claims would overcome this rejection.

*Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.      Claims 1-2, 4, 7, 9-10, 14-15 and 20 are rejected under 35 U.S.C. 102(b) as being

anticipated by McLay et al., (hereinafter McLay), US 4,072825.

With respect to claim 1 McLay discloses a method in a computer system for applying an

effect to a physical environment (a hotel), the environment having a plurality of spaces (rooms in

a hotel), comprising grouping the plurality of spaces into a plurality of groups (all room are

grouped in various categories, such as rooms needed to be clean, rooms, rooms with message

waiting indicators controlled centrally, rooms with requested wake-up calls etc. – see at least the

abstract); determining a group of spaces from the plurality of groups (such as unoccupied

rooms); determining an effect to be applied to the determined group (such as automatically

disabling outgoing calls); and causing the determined effect to be applied to the spaces of the

determined group such that the effect is applied to each space belonging to the group.

As pertaining to claim 2, the above described environmental effect is applied to all

rooms.

As pertaining to claim 4, the acts of determining an effect is capable of being performed

from at least one of the plurality of spaces (occupancy monitor in a particular room).

As pertaining to claims 7 and 20, the spaces are rooms in a building (hotel).

Claims 9-10 and 14-15 have similar limitations and therefore are rejected on the same

grounds (it is understood that the computer system of McLay inherently required to have

recorded computer readable instructions.

### *Double Patenting*

6.      The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees.    A nonstatutory obviousness-type double patenting rejection
is appropriate where the conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference
claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re
Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).


7.      Claims 1-21 are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 17, 24, 27, 29-32, 39, 41, 42 and 46-49 of U.S.

Patent No. 6,670,934 B1.  Although the conflicting claims are not identical, they are not

patentably distinct from each other because the claims of the pending application are broader

version of the Patent claims and therefore would be easily derived from the latter.

| Application | Patent |
| --- | --- |
|  |  |

1. A method in a computer system for applying an effect to a physical environment, the environment having a plurality of spaces, comprising: grouping the plurality of spaces into a plurality of groups; determining a group of spaces from the plurality of groups; determining an effect to be applied to the determined group; and causing the determined effect to be applied to the spaces of the determined group such that the effect is applied to each space belonging to the group.

2. The method of claim 1 wherein the effect is the controlling of environmental conditions, such that causing the effect to be applied to the spaces of the determined group controls the environmental conditions of all of the spaces belonging to the determined group.

3. The method of claim 2 wherein the effect is displaying an image on a display device.

4. The method of claim 2 wherein the acts of determining an effect is capable of being performed from at least one of the plurality of spaces.

5. The method of claim 3 wherein the image is an electronic art image.

6. The method of claim 3 wherein the image is one of a plurality of images that are displayed in sequence at periodic intervals.

7. The method of claim 1 wherein the spaces are rooms in building.

8. The method of claim 1 comprising determining a second group of spaces from the plurality of groups and determining a second effect to be applied to the second group of spaces.

9. A data signal transmitted over a computer-

17. A method in a system for displaying images in a physical environment, the environment having a plurality of spaces, each space having an associated display device capable of displaying an image, comprising: associating the plurality of spaces with a first hierarchical group; determining a first image to be displayed in the spaces of the first group; and causing the first image to be displayed on the display devices associated with the spaces of the first group, such that each space of the first group displays the first image while the other spaces of the first group also display the first image.

24. The method of claim 17, wherein the determined first image is an art image.

25. The method of claim 17, wherein the determined first image comprises a play list of multiple images.

27. The method of claim 17 wherein each space has a user control point device for receiving input.

29. The method of claim 27 wherein the first image is determined using the user control point device.

30. The method of claim 27 wherein the first group is determined using the user control point device.

31. The method of claim 27 wherein the spaces are associated with the first group using the user control point device.

32. A computer-readable memory medium containing instructions for controlling a computer processor to display images in a physical environment, the environment having a plurality of spaces, each space having an associated display device capable of displaying an image, by: associating the plurality of spaces with a first hierarchical group;

readable data transmission medium containing instructions for controlling a computer system to apply effects to a physical environment, the environment having a plurality of spaces, by: grouping the plurality of spaces into a plurality of groups; determining a group of spaces from the plurality of groups; determining an effect to be applied to the determined group; and causing the determined effect to be applied to the spaces of the determined group such that the effect is applied to each space belonging to the group.

10. The data signal of claim 9 wherein the effect is the controlling of environmental conditions, such that causing the effect to be applied to the spaces of the determined group controls the environmental conditions of all of the spaces belonging to the determined group.

11. The data signal of claim 9 wherein the effect is displaying an image.

12. The data signal of claim 9 wherein the computer-readable data transmission medium is a network.

13. The data signal of claim 12 wherein the computer-readable data transmission medium is the internet.

14. A system for applying effects to a physical environment having a plurality of physical spaces, comprising: a computer having a plurality of computer-readable instructions for providing a plurality of logical groups where each logical group corresponds to a plurality of the physical spaces of computer readable instructions capable of executing on the computer for selecting one of the logical groups; a plurality of computer readable instructions capable of executing on the computer for selecting an effect to be applied to the selected logical group; an interface

determining a first image to be displayed in the spaces of the first group; and causing the first image to be displayed on the display devices associated with the spaces of the first group, such that each space of the first group displays the first image while the other spaces of the first group also display the first image.

39. The computer-readable memory medium of claim 32, wherein the determined first image is an art image.

41. The computer-readable memory medium of claim 32 wherein each space has a user control point device for receiving input.

42. A system for displaying images in a physical environment, the environment having a plurality of spaces, each space having an associated display device capable of displaying an image, comprising: plurality of art space controllers, each associated with a space of the plurality of spaces and the associated display device of the space, that each receive an indication of an image; and cause the associated display device of the associated space to display the indicated image in the space; and art administration system that associates a plurality of the spaces with a first hierarchical group; determines a first image to be displayed in the spaces that belong to the first group; and sends an indication of the first image to the art space controller associated with each space that belongs to the first group.

46. The system of claim 42, further comprising: user control point device that receives selections from an operator and transmits the selections to the art administration system to arrange the plurality of spaces into hierarchical groups and to select images for display.

47. The system of claim 42, further comprising: image server that receives a

capable of transmitting a signal indicative of the physical effect to computing devices associated with each physical space in the logical group so that the computing device may cause the effect to be applied to the physical space.

15. The system of claim 14 wherein the effect is the controlling of environmental conditions, such that causing the effect to be applied to the spaces of the determined group controls the environmental conditions of all of the spaces belonging to the determined group.

16. The system of claim 15 wherein the effect is displaying an image on a display device associate with each computing device.

17. The system of claim 15 wherein the an effect is capable of being selected by a transmission from at least one of the computing devices.

18. The system of claim 16 wherein the image is an electronic art image.

19. The system of claim 16 wherein the image is one of a plurality of images that are capable of being displayed in sequence at periodic intervals.

20. The system of claim 14 wherein the spaces are rooms in building.

21. The system of claim 14 comprising a plurality of computer readable instruction capable of executing on the computer for selecting a second one of the logical groups from the plurality of logical groups; and a plurality of computer readable instruction capable of executing on the computer for selecting a second effect to be applied to the second group of spaces.

request for an indicated image for an indicated space, retrieves the indicated image, and forwards the retrieved image to the art space controller associated with the indicated space.

48. The system of claim 47 wherein the indicated image is retrieved from an image storage system that is not located at the image server.

49. The system of claim 42 wherein the first image is an art image.

## *Conclusion*

8.    The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
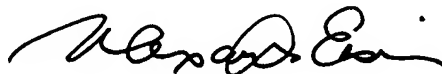
**Daniels et al., US 5,310,349.**

**Kenet, US 5,165,465.**

9.    Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (571) 272-7687. The examiner can normally be reached on M-F (9:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/26/06

Alexander Eisen
Primary Examiner
Art Unit 2629